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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,480	01/15/2004	Maria Rooney	ROONEY-001XX	6192
7590 02/08/2005			EXAMINER	
Bourque & Associates, P.A. Suite 301 835 Hanover Street Manchester, NH 03104			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding..

Office Action Summary

Application No.

10/758,480

Applicant(s)

ROONEY, MARIA

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/8/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the spherical shape of claim 4 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Figure 4 currently shows a hemispherical shape.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 5 and 6 are objected to because of the following informalities: the claims recite "said enclosure includes generally triangular/trapezoidal in shape"; the examiner recommends replacement of "includes" with --is--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Independent claims 1, 16, and 20 each claim "at least one side"; while the disclosure is enabling for a single side (hemispherical shape), it is not enabling for more than 5 sides. The examiner questions how an enclosure with 13 sides would be arranged. Claims 2, 5 and 6 appear to rectify the problem, but do not disclose the opening and card-holding assembly on the same side as required by claim 1 (on which they depend).

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4. Claims 1-15 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said at least one opening" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claims 2-15 are dependent on claim 1 and are rejected for the above reason.

Claim 20 recites the limitation "said card holding assembly" in line 11. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 9, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Carroll (US 5,366,192).

Regarding claim 1, inasmuch as the examiner can determine the scope of the claim, Carroll discloses a gift with an enclosure **4** having a base **12**, a sidewall (**16 & 28**), an opening **28c**, a card-holding assembly (**20 & 24**), and receptacle **8**. Carroll meets all limitations claimed by the applicant.

As to claim 9, Carroll discloses viewing window **16b**.

As to claim 12, Carroll discloses vial **8**.

As to claim 13, vial **8** is capable of containing liquid.

6. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Shuen (US 6,237,788).

Regarding claim 1, inasmuch as the examiner can determine the scope of the claim, Shuen discloses a gift with an enclosure **1** having a base **252**, sides **10 & 20**, opening **11**, card-holding assembly **15** capable of functioning as claimed, and receptacle **154**.

As to claim 4, Shuen is generally spherical in shape.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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7. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll (US 5, 366, 192), as applied to claims 1 and 9 above, and further in view of Larson (US 5,682,999).

Carroll discloses the claimed invention except for the indicia.

Larson discloses themed indicia for a gift (see Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the gift of Carroll with themed indicia as taught by Larson in order to convey a message or sentiment to the recipient (see Larson Col. 1, lines 14-19).

8. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll (US 5,366,192).

Regarding claims 14 and 15, Carroll, as applied to claim 1 above, discloses the claimed invention except for the tinted, translucent material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form Carroll from tinted, translucent material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

9. Claims 1-3, 7, 12, 13, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendix (US 6,138,828) in view of Carroll (US 5, 366, 192).

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Regarding claim 1, inasmuch as the examiner can determine the scope of the claim, Bendix discloses a gift (Figure 4) with an enclosure **30** having a sides and openings (Col 4, lines 52-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the enclosure of Bendix with a base in order to retain fluids that may leak during transport.

Bendix (as modified with a base) merely lacks a card-holding assembly.

Carroll discloses a card-holding assembly (**20 & 24**) for a gift. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the gift of Bendix with a card-holder as taught by Carroll in order to present a message to be conveyed to the recipient (see Carroll Col. 2, lines 56-59). The location of the card-holder is deemed an obvious matter of design choice.

As to claims 2 and 3, the enclosure of Bendix is generally rectangular in shape. The location of the card-holder is deemed an obvious matter of design choice.

As to claim 7, Bendix discloses the claimed invention except for the plurality of card-holders. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the gift of Bendix-Carroll with a plurality of card-holders, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

As to claim 12, Bendix discloses vial **10**.

As to claim 13, vial **10** is capable of containing liquid.

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Regarding claim 16-18, the gift of Bendix-Carroll, as applied to claim 1, discloses the claimed invention.

10. Claims 11, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendix-Carroll as applied to claims 1 and 16 above, and further in view of Hodges (US 5,706,947).

Regarding claims 11 and 19, Bendix-Carroll discloses the claimed invention except for the expandable card-holder.

Hodges discloses an expandable card-holder used to retain a plurality of gifts. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the gift of Bendix-Carroll with an expandable card-holder as taught by Hodges in order to enable the provision of a plurality of gifts.

Regarding claim 20, Bendix-Carroll-Hodges, as applied to claim 19 above, discloses the claimed invention except for the translucent support body. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the gift of Bendix-Carroll-Hodges from translucent material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

11. Claims 1, 5, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCauley (US 1,518,207) in view of Whittington (US 1,855,879).

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Regarding claim 1, inasmuch as the examiner can determine the scope of the claim, McCauley discloses a gift with an enclosure (Figures 1-4), having a base **7**, sides **1 & 5**, an opening **11**, a card-holding assembly **9**, and a receptacle **2**. McCauley merely lacks the card-holding assembly and opening on the same side.

Whittington discloses a gift with a card-holding assembly **7** and opening **9** on the same side. It would have been obvious to one having ordinary skill in the art at the time the invention was made to relocate the opening of McCauley to the side with the card-holder, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

As to claim 5, McCauley is generally triangular in shape.

As to claim 12, McCauley discloses vial **2**.

As to claim 13, vial **2** is capable of containing liquid.

12. Claims 1, 6, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neiser (US 4,819,803) in view of Carroll (US 5,366,192).

Regarding claim 1, inasmuch as the examiner can determine the scope of the claim, Neiser discloses a gift with an enclosure **10** having a base **26**, sides **28, 30, 32, 34**, opening (aperture formed by slots **40 & 42**), and receptacle **V**.

Neiser merely lacks the card-holding assembly.

Carroll discloses a card-holding assembly (**20 & 24**) for a gift. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the gift of Neiser with a card-holder as taught by Carroll in order to present a

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message to be conveyed to the recipient (see Carroll Col. 2, lines 56-59). The location of the card-holder is deemed an obvious matter of design choice.

As to claim 6, Neiser discloses a generally trapezoidal shape.

As to claim 12, Neiser discloses vial **V**.

As to claim 13, vial **V** is capable of containing liquid.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

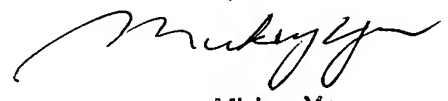
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
31 January 2005


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